



115

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

) PATENT APPLICATION

)

Inventor(s): Rocky Stewart et al.

)

SC/Serial No.: 09/785,693

) Art Unit: 2635

Confirm. No.: 3894

) Examiner: Unassigned

Filed: February 16, 2001

)

Title: CONVERSATION MANAGEMENT
SYSTEM FOR ENTERPRISE WIDE
ELECTRONIC COLLABORATION

)

Customer No. 23910

)

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited in the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Box Missing Parts, Commissioner for Patents, Washington, DC 20231, on July 18, 2001.

A handwritten signature of Karl Kenna.

(Agent Signature)

Karl Kenna, Reg. No.: 45,445

Signature Date: July 18, 2001

PETITION UNDER 37 C.F.R. §1.47 ON BEHALF OF
SIGNING INVENTORS TO ACCEPT DECLARATION IN RESPONSE TO
A MISSING PARTS WITHOUT THE SIGNATURE OF A JOINT INVENTOR

Box Missing Parts
Commissioner for Patents
Washington, DC 20231

Sir:

The signing inventors, through the below-signed attorney in the above-identified application, hereby petition the Commissioner to accept Applicants' Response to Notice to File Missing Parts.

07/24/2001 SDIRETA1 00000034 09785693

02 FC:122

130.00 OP

- 1 -

Attorney Docket No.:BEAS-01033US5 SRM/KFK
kfk/beas/1033/1033us5/1033us5.petition by signing inventors.wpd

Avoidance of Further Delay

To avoid any further delay and additional fees in its Response to the Notice to File Missing Parts in the above, and to submit all formal documents in a timely manner, the signing inventors petition the Commissioner to deem Applicants' missing parts requirement fulfilled, and to proceed with further prosecution of the herein case without further attempts required of Applicants in obtaining Inventor Timo Metsaportti's execution of formal documents.

Applicants' Response to Notice to File Missing Parts is enclosed along with all required formal documents.

Also enclosed is a \$130.00 petition fee required by 37 CFR §1.17(i), and included in the total amount submitted in Applicant's Response to Notice to File Missing Parts.

The Commissioner is hereby authorized to charge underpayment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 06-1325. A duplicate copy of this authorization is enclosed.

Respectfully submitted,

FLIESLER DUBB MEYER & LOVEJOY LLP

Date: July 18, 2001

By: 
Karl Kenna
Reg. No. 45,445

FLIESLER DUBB MEYER & LOVEJOY LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
Telephone: (415) 362-3800



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application)	<u>PATENT APPLICATION</u>
)	
Inventor(s): Rocky Stewart et al.)	
SC/Serial No.: 09/785,693)	Art Unit: 2635
Confirm. No.: 3894)	Examiner: Unassigned
Filed: February 16, 2001)	
Title: CONVERSATION MANAGEMENT)	
SYSTEM FOR ENTERPRISE WIDE)	
ELECTRONIC COLLABORATION)	<u>Customer No. 23910</u>
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(Agent Signature)

Karl Kenna, Reg. No. 45,445
Signature Date: July 18, 2001

DECLARATION UNDER 37 C.F.R. §1.47 ON BEHALF OF
SIGNING INVENTORS IN SUPPORT OF
PETITION TO ACCEPT DECLARATION IN RESPONSE TO
A MISSING PARTS WITHOUT THE SIGNATURE OF A JOINT INVENTOR

Box Missing Parts
Commissioner for Patents
Washington, DC 20231

Sir:

Applicants, through their undersigned attorney, hereby petitions the Commissioner to accept Applicants' Response to Notice to File Missing Parts in the above-identified application. Applicants make the following declaration:

Declaration by Applicant

1. Inventor Timo Metsaportti, a former employee of BEA Systems, Inc., is a joint inventor in the above-identified application, as well as other recently filed patent applications, assigned or to be assigned to BEA Systems, Inc.

2. On April 17, 2001, Applicants' attorney, in his customary practice of obtaining updated inventorship information for inventors and employees of BEA Systems, Inc., sent an email to inventor Timo Metsaportti at his email address at BEA Systems, Inc. identified as follows: timo.metsaportti@beasys.com. A copy of the email is attached and incorporated herein by reference as Exhibit A. The undersigned received no response.

3. On April 24, 2001, Applicants' attorney sent a second email to inventor Metsaportti at the above-identified email address, and again received no response. Copy of the email is attached and incorporated herein by reference as Exhibit B.

4. On April 27, 2001, after learning that Inventor Metsaportti was no longer employed by BEA Systems, Inc., and after preparing the necessary formal documents required in all newly filed patent applications where Inventor Metsaportti is listed as a joint inventor, Applicants' attorney sent via FedEx multiple declaration and assignment documents, as well as copies of all applicable patent applications, to Inventor Metsaportti's last known home address for review and execution. Applicants' attorney received an email confirmation from FedEx that the above FedEx package was delivered to the address indicated on April 30, 2001 and the package was signed for by Irene Summanen. Copy of FedEx email confirmation is attached and incorporated herein by reference as Exhibit C.

5. On May 23, 2001, Applicants' attorney contacted Inventor Metsaportti's former employer BEA Systems, Inc. for Inventor Metsaportti's last known home telephone number, and attempted to contact Inventor Metsaportti, but received no response.

6. On June 6, 2001, Applicants' attorney attempted to contact Inventor Metsaportti again at his last known home telephone number, and learned that the telephone number was invalid.

7. Applicant believes it has made a diligent effort in attempting to contact Inventor Metsaportti so as to fulfill the formal documents requirement in a timely manner. Due to Inventor Metsaportti's non-response to Applicant's numerous attempted contacts over a course of

approximately two months, Applicants conclude that Inventor Metsaportti is refusing to execute all formal documents required by the Notices to File Missing Parts in all recently filed patent applications listing Inventor Metsaportti as a joint inventor.

8. Inventor Timo Metsaportti's last known contact information is Koivunrunko 8B, Espoo, Finland 02130, telephone number 011 3588 301008.

Respectfully submitted,

FLIESLER DUBB MEYER & LOVEJOY LLP

Date: July 18, 2001

By: 
Karl Kenna
Reg. No. 45,445

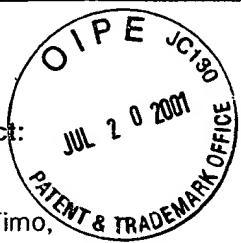
FLIESLER DUBB MEYER & LOVEJOY LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
(415) 362-3800

Mary Buggie

Exhibit A

From: Mary Buggie
Sent: Tuesday, April 17, 2001 2:45 PM
To: 'timo.metsaportti@bea.com'
Subject: Information Needed

Dear Timo,



We are in the process of preparing formal documents for your signature for the following patent applications we filed for BEA Systems on February 16, 2001:

Open Market Collaboration System for Enterprise Wide Electronic Commerce
Message Routing System for Enterprise Wide Electronic Collaboration
Conversation Management System for Enterprise Wide Electronic Collaboration
Workflow Integration System for Enterprise Wide Electronic Collaboration

However, we do not have your country of citizenship on file, which is required on the Declaration for Patent Application document.

Please provide us with your country of citizenship as soon as possible so we may send you the formal documents.

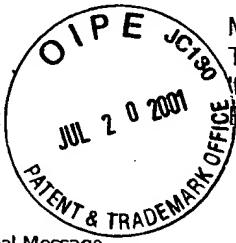
Thank you,

Mary Buggie
Assistant to Karl Kenna
Fliesler Dubb Meyer & Lovejoy LLP
Four Embarcadero Center
Fourth Floor
San Francisco, CA 94111
(415) 362-3800, xt. 278
(415) 362-2928 fax
mbuggie@fdml.com

Mary Buggie

Exhibit B

From: Mary Buggie
Sent: Tuesday, April 24, 2001 4:06 PM
To: 'timo.metsaportti@beasys.com'
Subject: FW: Information Needed



-----Original Message-----

From: Mary Buggie
Sent: Tuesday, April 17, 2001 8:35 AM
To: 'timo.metsaportti@bea.com'
Cc: Karl Kenna; Jan Smith
Subject: Information Needed

Dear Timo,

We are in the process of preparing formal documents for your signature for the following patent applications we filed for BEA Systems on February 16, 2001:

Open Market Collaboration System for Enterprise Wide Electronic Commerce
Message Routing System for Enterprise Wide Electronic Collaboration
Conversation Management System for Enterprise Wide Electronic Collaboration
Workflow Integration System for Enterprise Wide Electronic Collaboration

However, we do not have your country of citizenship on file, which is required on the Declaration for Patent Application document.

Please provide us with your country of citizenship as soon as possible so we may send you the formal documents.

Thank you,

Mary Buggie
Assistant to Karl Kenna
Fliesler Dubb Meyer & Lovejoy LLP
Four Embarcadero Center
Fourth Floor
San Francisco, CA 94111
(415) 362-3800, xt. 278
(415) 362-2928 fax
mbuggie@fdml.com

Exhibit C

Mary Buggie P.F.

From: sysdeliv@esprim6.prod.fedex.com
Sent: Wednesday, May 02, 2001 6:45 AM
To: mbuggie@fdml.com
Subject: FedEx shipment 791147043041



Our records indicate that the shipment sent from KARL KENNA/FLIESLER DUBB MEYER & LOVEJOY to Timo Metsaportti has been delivered.

The package was delivered on 4/30/2001 at 12:11 PM and signed for or released by I.RENE S-SUMMANEN.

The ship date of the shipment was 4/27/2001.

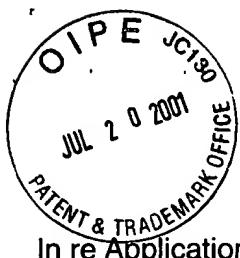
The tracking number of this shipment was 791147043041.

Thank you for shipping with FedEx Ship Manager at FedEx.com.
https://www.fedex.com/cgi-bin/ship_it/interNetShip/

To track the status of this shipment on line click on the following:
http://www.fedex.com/cgi-bin/tracking?tracknumbers=791147043041&action=track&language=english&cntry_code=us

Disclaimer

FedEx has not validated the authenticity of any email address.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

) PATENT APPLICATION

Inventor(s): Rocky Stewart, et al.

)

SC/Serial No.:09/785,693

)

Filed: February 16, 2001

)

Conf. No.: 3894

)

Title: CONVERSATION MANAGEMENT
SYSTEM FOR ENTERPRISE WIDE
ELECTRONIC COLLABORATION

)

Customer No. 23910

DECLARATION FOR PATENT APPLICATION

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name; I believe that I am the original, first and sole inventor (if one name is listed below), first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

CONVERSATION MANAGEMENT SYSTEM FOR ENTERPRISE WIDE ELECTRONIC
COLLABORATION

the specification of which (check applicable ones):

is filed herewith;

_____ X _____

was filed with the above-identified "Filed" date and "SC/Serial No."

was amended on (or amended through) _____.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose information which is material to the examination of the application in accordance with Title 37, Code of Federal Regulations, §1.56.

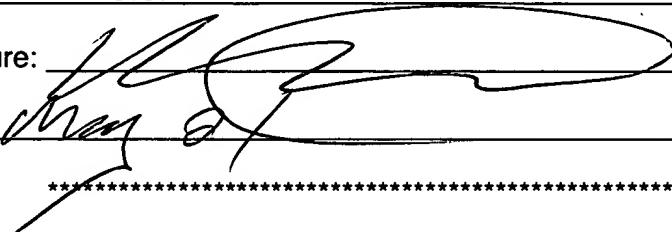
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

(1) Full name of sole
or first inventor: Rocky Stewart

(1) Residence: 11 Saddleback Court
Danville, CA 94506

(1) Post Office Address: 2315 North First Street
San Jose, CA 95131

(1) Citizenship: U.S.

(1) Inventor's signature: 

(1) Date: 10 May 01

(2) Full name of second joint inventor: Pal Takacs-Nagy

(2) Residence: 10553 Farallone Drive
Cupertino, CA 95014

(2) Post Office Address: 2315 North First Street
San Jose, CA 95131

(2) Citizenship: Hungary

(2) Inventor's signature: Pal Takacs-Nagy

(2) Date: 5/9/01

(3) Full name of third
joint inventor: Timo-Metsaportti

(3) Residence: Koivunrunko 8B
Espoo, Finland 02130

(3) Post Office Address: 2315 North First Street
San Jose, CA 95131

(3) Citizenship: Finland

(3) Inventor's signature: _____

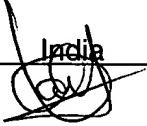
(3) Date: _____

(4) Full name of fourth joint inventor: Sanjay Dalal

(4) Residence: 575 E. Remington Dr., #12M
Sunnyvale, CA 94087

(4) Post Office Address: 2315 North First Street
San Jose, CA 95131

(4) Citizenship: India

(4) Inventor's signature: 

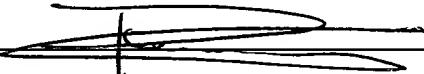
(4) Date: 5/4/01

(5) Full name of fifth joint inventor: Pascal Hoebanx

(5) Residence: 2896 Pruneridge Ave.
Santa Clara, CA 95051

(5) Post Office Address: 2315 North First Street
San Jose, CA 95131

(5) Citizenship: Belgium

(5) Inventor's signature: 

(5) Date: May 15th, 2001

Title 37, Code of Federal Regulations, §1.56

**SECTION 1.56. DUTY TO DISCLOSE INFORMATION
MATERIAL TO PATENTABILITY**

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§1.97(b)-(d) and 1.98.* However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
 - (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.
- (b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and
- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

- (i) Opposing an argument of unpatentability relied on by the Office; or
- (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
- (2) Each attorney or agent who prepares or prosecutes the application; and
- (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

* §§1.97(b)-(d) and 1.98 relate to the timing and manner in which information is to be submitted to the Office.